

UNITED STATES DISTRICT COURT
FOR THE DISTRICT OF MASSACHUSETTS

BIOGEN, INC., ET AL)	CA 03-11329
)	Boston, MA
v.)	June 22, 2004
)	
COLUMBIA UNIVERSITY, ET AL)	

BEFORE THE HONORABLE MARK L. WOLF
UNITED STATES DISTRICT JUDGE

APPEARANCES:

(As previously noted.)

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1 MR. GINDLER: Yes, Immunex asked for a copy of
2 the then current claims, and we said, okay. They didn't
3 have a right to it, but they asked. They didn't say, we
4 have a contractual right to this. They said, we'd like
5 to see it. Can we have it? And Mr. White said, sure,
6 you can have the copy of the then pending claims. They
7 didn't have a right to it. No one else has a right to
8 it. They can ask. We can say yes. We can say no. And
9 there are reasons that we might say yes and reasons that
10 we might say no. We might say yes because it might
11 encourage them to keep their license in place, keep
12 paying fees. We might say no. But it's just the
13 parties' agreement. The parties made these agreements,
14 and they should live by it. Our agreement says, you pay
15 royalties until the patent -- unless and until the patent
16 is held invalid by a court of competent jurisdiction.

17 THE COURT: What would happen if I ordered that
18 you -- you know, that I denied the preliminary injunction
19 with regard to the '275 but not the '636 or the potential
20 '159?

21 MR. GINDLER: They would keep the license to
22 the '636 and the '159. If the '159 became a patent, they
23 would be licensed and obligated to pay us royalties.

24 THE COURT: And is that a problem for Columbia?

25 MR. GINDLER: Well, it doesn't honor the

1 license agreement. But is it a problem? Well, if they
2 were to pay us on the patent if the '159 issues, that
3 would be great. I have this really bad feeling that they
4 don't plan to do that, that when the '159 issues, if it
5 issues, they're going to challenge that patent too. So
6 I'm not feeling so good that we're going to get money
7 from them at the end of the day, but --

8 THE COURT: When do you expect a decision from
9 the Patent Office on the '159?

10 MR. GINDLER: Oh, I can never predict how
11 quickly they're going to act.

12 THE COURT: Well, have you made all the --

13 MR. GINDLER: I think it's fair to say the
14 following, that we're pretty much toward the end of the
15 process.

16 THE COURT: Is it affected by the reexamination
17 and reissuance regarding the '275?

18 MR. GINDLER: Nothing we've been told by the
19 Patent Office says that. It wouldn't surprise me if it
20 were, because there must be overlapping issues, but I
21 just don't know if they're going to look at them together
22 or not.

23 THE COURT: And if I ordered that you couldn't
24 terminate them with regard to the '636 and '159, should I
25 order that they pay something and, if I ordered that they

1 pay something, would that destroy subject matter
2 jurisdiction because they're not paying in connection
3 with -- they're not licensing the '275; is there a real
4 case in controversy?

5 MR. GINDLER: I don't think so because the
6 reason that they're here is not because of the '636 or
7 the '159. They're here because they really don't like
8 that '275 patent.

9 THE COURT: So you think there would be a real
10 case of controversy?

11 MR. GINDLER: Well, there is a case of
12 controversy about the '275.

13 THE COURT: So, if I entered that more limited
14 injunction because I thought, given the two Cordis cases
15 and Gen-Probe, it's legally permissible, and that's the
16 equitable way to strike the balance, you would not argue
17 that that destroyed subject matter jurisdiction?

18 MR. GINDLER: That's correct. If you ordered
19 them -- if you enjoined us from terminating on '636 and
20 '159, as long as they complied with their contractual
21 obligations as to '636 and '159, I don't think there
22 would be any destruction of subject matter jurisdiction
23 here on the '275 issues.

24 THE COURT: And when you say pay for it, that's
25 \$30,000 a year, which is applied against royalties.